



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,132	02/28/2005	Terrence E Hogan	P02039US2A	2691

7590 10/28/2009
John M Vasuta
Chief IP Counsel
Bridgestone Americas Holding
1200 Firestone Parkway
Akron, OH 44317

EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

10/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,132	Applicant(s) HOGAN ET AL.	
	Examiner Roberto Rábago	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,8,12,14 and 16-21 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9,10,13,15 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend from “the method of claim 1.” However, claim 1 is not a method claim, but rather a composition claim, and therefore the intended method is indefinite. The claims are furthermore indefinite because no method steps are recited.

Claims 22-24 are also rejected under 35 U.S.C. 101 because the claimed recitation of a method, without setting forth any steps involved in the method, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

These claims cannot be further examined because it cannot be determined whether the error is in the class of invention or in the identification of the parent claim. However, it is noted that the disclosure cited in support of this new claim only covers styrene/butadiene copolymer, and does not disclose the range of 1,2 content for the other polymers specified in claim 23.

Claim Rejections - 35 USC § 102

Art Unit: 1796

2. Claims 1, 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapuschinski et al. (US 5,374,364) for the reasons set forth in item 1 of the Office action mailed 3/17/2009.

Applicant's arguments filed 6/15/2009 have been fully considered but they are not persuasive. Reliance on Kapuscinski Example 1 is withdrawn; however, previously cited disclosure at col. 3 discloses polymers of isoprene, styrene/butadiene and styrene/isoprene. The fact that the reference discloses such materials as hydrogenated does not exclude them from the scope of the claims because, since hydrogenation processes do not typically achieve 100% hydrogenation, at least a non-zero amount of unhydrogenated diene monomer residue would be expected to remain in the final polymer. Contrary to applicants' assertion, the claims do not exclude polymers with at least some hydrogenated content, and the claims are silent regarding backbone unsaturation. Regarding applicants' argument directed to terminal functionalization, the reaction of Kapuscinski would be expected to result in at least a single occurrence of tail-end functionalization in view of decreased steric hindrance near the polymer terminus. The burden of proof is shifted to applicants to show otherwise.

Double Patenting

3. Claims 1, 4 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/900,686 for the reasons set forth in item 5 of the Office action mailed 2/25/2008.

4. Claims 1, 4 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 13-31 of Patent 7,462,677, for the reasons set forth in item 5 of the Office action mailed 2/25/2008. The original provisional rejection over 11/900,664 is no longer provisional because the application has matured into patent 7,462,677.

5. Claims 1, 4 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16, 18 and 22 of copending Application No. 11/331,663 for the reason set forth in item 6 of the Office action mailed 2/25/2008.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 3, 4, 6, 9, 10, 13 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-68 of Patent 7,186,845 for the reason set forth in item 7 of the Office action mailed 2/25/2008.

Applicant's arguments filed 6/15/2009 have been fully considered but they are not persuasive. Applicants argue that the instant claims are distinguished over the reference claims because the functional group α is at the terminal end of the polymer. However, the reaction specified in the patented claims would be expected to result in at least a single occurrence of tail-end functionalization in view of decreased steric

Art Unit: 1796

hindrance near the polymer terminus. The burden of proof is shifted to applicants to show otherwise.

7. Claims 2, 8, 12, 14 and 16-21 are allowed. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1796

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
October 26, 2009